

REMARKS

In the office action dated September 5, 2003, the Examiner rejected Claims 1-32 under 35 U.S.C. § 112 as being indefinite. Claims 1, 4-6, 10, 12, 15-18, 23 and 26-28 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,383,874 ("Jackson et al") in view of U.S. Patent No. 5,400,267 ("Denen et al"). Claims 2, 3, 7-9, 11, 13, 14, 19-22, 24, 25 and 29-32 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Jackson et al in view of Denen et al and in further view of U.S. Patent No. 6,119,913 ("Adams et al"). Claims 33-41 and 43 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Adams et al. Lastly, Claims 42 and 44 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Adams et al in view of U.S. Patent No. 5,433,721 ("Hooven et al").

The office action and the references cited therein have been carefully considered. In view of the amendments presented herewith, and based on the following remarks, Applicants submit that the instant application is in condition for allowance.

Claim Rejections - 35 U.S.C. § 112

The Examiner rejected claims 1-32 as being indefinite, based on language in independent claims 1, 12 and 23 which recites "a memory unit housed inside the surgical instrument and adapted for complete insertion in the body with the instrument." Although Applicants believe that the claim language is clear, Applicants have revised claims 1, 12 and 23 to recite "a memory unit housed inside the surgical instrument so that the surgical instrument and the memory unit disposed within said

surgical instrument can both be completely inserted into the body.” Applicants respectfully believe that this revised language is clear, and that the rejection based on indefiniteness is traversed without any alternation in the scope of the claim.

The Examiner noted that functional claim language, such as the recitation “adapted for complete insertion in the body” previously presented in claims 1, 12 and 23 is not a positive limitation in any patentable sense. In support of this sweeping proposition, the Examiner cites *In re Hutchinson*, 69 USPQ 138 (CCPA 1946). *In re Hutchinson* does not support the Examiner’s position. The claim language in *In re Hutchinson* is distinguishable from the Applicants’ claim language. The Court’s statement *In re Hutchinson* was dictum and only applied to the specific claim language under review in that case, not all functional claim language. Moreover, the functional language in *In re Hutchinson* appeared in the claim preamble, and only stated an intended use for the invention. In contrast, the functional language in Applicants’ claims 1, 12 and 23 appears in the body of the claims and is not merely a statement of intended use.

The current view on functional limitations is found in *In re Venezia*, 189 USPQ 149 (CCPA 1976). According to *In re Venezia*, functional limitations that define structural attributes of interrelated component parts of a claimed assembly are acceptable limitations and must be considered. *In re Venezia*, 189 USPQ 149 (CCPA 1976); *see also* MPEP § 2173.05(g). Therefore, the revised functional language in Claims 1, 12 and 23 which is directed to the relative size and arrangement of components of the invention must be considered as a positive recitation by the Examiner.

Claim Rejections - 35 U.S.C. § 103

Claims 1, 4-6, 10, 12, 15-18, 23 and 26-28

The Examiner rejected claims 1, 4-6, 10, 12, 15-18, 23 and 26-28 as being obvious over Jackson et al in view of Denen et al. Applicants have amended claims 1, 12 and 23 to recite "a memory unit housed inside the surgical instrument so that the surgical instrument and the memory unit disposed within said surgical instrument can both be completely inserted into the body."

Jackson et al fails to teach or suggest a surgical instrument and a memory unit disposed within the surgical instrument wherein both the surgical instrument and the memory unit can be completely inserted into the body. Instead, Jackson et al teaches a catheter 14 having an identification means 76 carried in the catheter handle 20. (Col. 6, lines 58-61; Fig. 1). The catheter handle 20 and the identification means 76 in the handle are not inserted into the body. The deficiency in Jackson et al is not remedied by combining Jackson et al with Denen et al. Denen et al teaches a scalpel 10 having a handle 11, a blade 12 and a memory 30 disposed within the handle. There is no suggestion in Denen et al that the handle 11 and memory 30 are configured to be completely inserted into the body together. Therefore, the combination of Jackson et al and Denen et al does not teach or suggest the instrument as claimed in amended claims 1, 12 and 23. Accordingly, such claims are patentable over the combination of Jackson et al and Denen et al.

Claims 4-6, 10, 15-18 and 26-28 are dependent on amended claims 1, 12 and

23 and incorporate all the features of claims 1, 12 and 23. Therefore, dependent claims 4-6, 10, 15-18 and 26-28 are patentable over Jackson et al and Denen et al for at least the same reasons that claims 1, 12 and 23 are patentable.

Claims 2, 3, 7-9, 11, 13, 14, 19-22, 24, 25 and 29-32

The Examiner rejected claims 2, 3, 7-9, 11, 13, 14, 19-22, 24, 25 and 29-32 as being unpatentable over Jackson et al in view of Denen et al and in further view of Adams et al. Claims 2, 3, 7-9, 11, 13, 14, 19-22, 24, 25 and 29-32 are dependent on amended claims 1, 12 and 23 and incorporate all the features of claims 1, 12 and 23, including a memory unit housed inside the surgical instrument so that the surgical instrument and the memory unit disposed within said surgical instrument can both be completely inserted into the body. Therefore, dependent claims 2, 3, 7-9, 11, 13, 14, 19-22, 24, 25 and 29-32 include subject matter not taught or suggested by Jackson et al and Denen et al. The deficiencies of Jackson et al and Denen et al are not remedied by combining them with Adams et al. In particular, Adams et al also fails to teach or suggest a memory unit housed inside the surgical instrument so that the surgical instrument and the memory unit disposed within said surgical instrument can both be completely inserted into the body. Instead, Adams et al only teaches a surgical instrument, with no memory unit within the surgical instrument. In fact, Adams et al does not suggest the use of a memory unit at all. Therefore, claims 2, 3, 7-9, 11, 13, 14, 19-22, 24, 25 and 29-32 are patentable over the combination of Jackson et al, Denen et al and Adams et al.

Claims 33-41 and 43

The Examiner rejected claims 33-41 and 43 as being obvious over Adams et al. Claim 33 has been amended to recite “a memory unit configured to store data representing at least one parameter relating to the surgical instrument”. As stated above, Adams et al does not teach or suggest a memory unit. Moreover, there is no evidence that a person having ordinary skill in the art would have been motivated to add a memory unit to the instrument in Adams et al. Therefore, amended claim 33 is patentable over Adams et al.

Claims 34-41 and 43 are dependent on amended claim 33 and incorporate all the features of amended claim 33. Therefore, claims 34-41 and 43 are patentable over Adams et al for at least the same reason that amended claim 33 is patentable. Therefore, the Applicants request that the Examiner reconsider the rejections to claims 33-41 and 43.

Claims 42 and 44

The Examiner rejected claims 42 and 44 as being obvious over Adams et al. in view of Hooven et al. Claims 42 and 44 are dependent on amended claim 33 and incorporate all the features of amended claim 33, including but not limited to a memory unit configured to store data representing at least one parameter relating to the surgical instrument. Adams et al does not teach or suggest a memory unit, as discussed above. The deficiency in Adams et al is not remedied by combining Adams et al with Hooven et al. Hooven et al teaches an endoscopic surgical instrument, but does not teach or suggest the use of a memory unit. Therefore, claims 42 and 44 are patentable over Adams et al in view of Hooven et al.


Conclusion

In light of the foregoing amendments and remarks, the Applicants believe that the application is in condition for allowance. The Examiner is encouraged to contact the Applicants' undersigned attorney if the Examiner believes that issues remain regarding the allowability of this application.

Respectfully submitted,

DANN DORFMAN HERRELL & SKILLMAN
A Professional Corporation
Attorneys for Applicants

By


Donald R. Piper, Jr.
PTO Registration No. 29,337

Telephone: (215) 563-4100
Facsimile: (215) 563-4044